



Patent

Attorney Docket No. 1033897-000002**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | |
|-----------------------------|---|-----------------------------|
| In re Patent Application of |) | MAIL STOP: ISSUE FEE |
| Yoshiki Hirano et al. |) | |
| Application No.: 10/658,392 |) | Group Art Unit: 2881 |
| Filed: September 10, 2003 |) | Examiner: Kiet Tuan Nguyen |
| For: ION ATTACHMENT MASS |) | Confirmation No.: 2266 |
| SPECTROMETRY METHOD |) | |

**REQUEST FOR RECONSIDERATION OF DECISION ON APPLICATION FOR PATENT
TERM ADJUSTMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In this application, a reply under 35 U.S.C. § 132 was filed on March 14, 2005. The U.S. Patent and Trademark Office was required to mail an Official Action by July 14, 2005 (4 months later). However, the U.S. Patent and Trademark Office did not properly mail an Official Action until March 7, 2006. The difference between the deadline for mailing the Official Action, *i.e.*, July 14, 2005, and the date when the U.S. Patent and Trademark Office mailed the Official Action, *i.e.*, March 7, 2006, is 236 days. Therefore, the term of any patent resulting from the above-identified U.S. Patent Application should be extended by 236 days, and such is requested. That argument was presented in an Application for Patent Term Adjustment.

The Office's Decision on the Application for Patent Term Adjustment indicates 0 days of patent term adjustment. That decision is based solely on the belief that the Office action of April 21, 2004 was correctly mailed by the Office and was subsequently returned because of a U.S. Postal Service error. That is not the case.

As evidenced by the attached copy of the front of the mailed envelope containing the Office action, it appears that the Office Action was not put in the envelope so that the address was visible. That evidences the fact that, contrary to the understanding expressed

in the Decision, that the Office incorrectly mailed the Office action thereby leading to the return on the Office action.

Because the error was on the part of the Office, the patent term adjustment should be calculated based on the Office action being properly mailed for the first time on March 7, 2006, not April 21, 2004.

Should any questions arise in connection with this application, it is requested that the undersigned counsel for Applicants be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: January 30, 2007

By:


Kevin Brayton McGoff
Registration No. 53,297

P.O. Box 1404
Alexandria, VA 22313-1404
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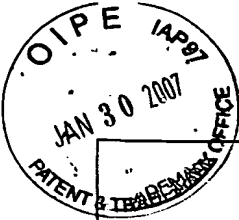
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/658,392 | 09/10/2003 | Yoshiki Hirano | 033897-002 | 2266 |
| 21839 | 7590 | 04/21/2004 | | |
| BURNS DOANE SWECKER & MATHIS L L P | | | | |
| POST OFFICE BOX 1404 | | | | |
| ALEXANDRIA, VA 22313-1404 | | | | |
| | | | EXAMINER | |
| | | | NGUYEN, KIET TUAN | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2881 | | |

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/658,392

Applicant(s)

HIRANO ET AL.

Examiner

Kiet T. Nguyen

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 provide for the use of a method, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet T. Nguyen whose telephone number is 571-272-2479. The examiner can normally be reached on Monday-Friday from 8.00 AM to 6.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee, can be reached on Monday-Friday. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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Art Unit: 2881

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KIET T. NGUYEN
PRIMARY EXAMINER



Organization

TC 2800

Bldg./Room

Jef1

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P.O. Box 1450

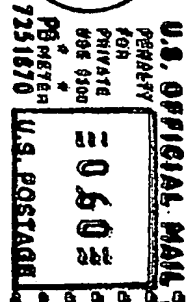
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